

REMARKS

Claims 1-28 are pending in this application. No amendments have been made to the claims.

Applicants' representative thanks the Examiner for the clear response to applicants' arguments filed July 6, 2004. The remarks made hereinbelow do not repeat the Applicants' previous arguments and Office is respectfully requested to consider these new remarks as Applicants' respectfully request reconsideration.

The Office Action rejects claims 1, 2, 12, 13, 24, 25, and 28 under 35 USC 102(e) as being anticipated by *Dusse*, U.S. Patent Publication No. 2002/0068554 (hereinafter *Dusse*). The Office Action rejects claims 3-7, 19, and 27 under 35 USC 103(a) as being unpatentable over *Dusse* in view of *Marwell et al.*, U.S. Patent No., 6,668,055 (hereinafter *Marwell*). The Office Action rejects claims 20-23 under 35 USC 103(a) as being unpatentable over *Dusse* in view of *Marwell* and further in view of *Calder et al.*, US Patent Publication No. 2001/0034244 (hereinafter *Calder*). The Office Action rejects claims 8-11, 14-18, and 26 under 35 USC 103(a) as being unpatentable over *Dusse* in view of *Kahan et al.*, US Patent Publication No. 2002/0024536 (hereinafter *Kahan*). Applicants respectfully traverse these rejections.

Applicants assert that *Dusse* does not disclose at least:

searching the mobile communication device for the requested sub-
feature

as recited in independent claim 1.

Dusse relates to an initial provisioning of a mobile device, that does not have features or services installed, with features and services selected from a list by its user. *Dusse* at ¶ 0032-0033. *Dusse* describes a method whereby a user is presented with a plurality of input and choice screens to select features and services to download to his or her mobile device. *See id.* at abstract; ¶ 0032-0033. *Dusse* does provide that the mobile device is pre-provisioned with "the content required to communicate with an automated Customer Service Center" *Dusse* at ¶ 0034. Accordingly, *Dusse*'s mobile device does include a client module 304 that performs routine tasks that may be necessary for initial operation of a new, unprovisioned, mobile device.

These tasks are described as establishing a communication session with a proxy server device via an airnet, such as CDPD network, operating and maintaining a resident address book,

displaying information on a display screen and receiving user input from a keypad. *Id.* at ¶ 0037.

Because *Dusse* is only concerned with, and only discloses, the initial provisioning of mobile devices, *Dusse* never discloses at least the element of “searching the mobile communication device for the requested sub-feature,” as recited in independent claim 1. *Dusse* does not disclose “searching ...” because in *Dusse*’s world, the “requested sub-feature” (which the Office reads on “features or services,” *see* Office Action at ¶10) would not, *a priori*, be provisioned on the mobile device. Thus, *Dusse* would have no need to search “the mobile communication device for [a] requested sub-feature” that *Dusse* has already indicated is not present (*i.e.*, provisioned). *See Dusse* at abstract; ¶¶ 0011, 0032, 0033; FIGS. 7A, 7B, 7C and associated text.

Furthermore, Applicants assert that *Dusse* does not disclose at least:

receiving, at the mobile communication device, a command to access said first service;

responsive to said command, determining whether said first set of features can satisfy said command

as recited in independent claim 12.

For the same reasons as provided above with respect to overcoming the rejection of independent claim 1, Applicants assert that at least the above-recited elements of independent claim 12 are not disclosed by *Dusse*. *Dusse* would have no need to determine whether a first set of features on a mobile device can satisfy a command to access a first service, because *Dusse* has already disclosed that any previously installed applications are non-operational and require provisioning. *Dusse* at ¶¶ 0040; *see also* abstract; ¶¶ 0011, 0032, 0033; FIGS. 7A, 7B, 7C and associated text.

Furthermore, Applicants assert that *Dusse* does not disclose at least:

a mobile communication device [having] a program to perform the operations of ...

determining whether said communication service can be satisfied by the mobile communication device as a stand alone device

as recited in independent claim 24.

The Office has stated that: “Initially the server determines that most of the communication services or features cannot be satisfied by the mobile device as a stand alone device ...” Office Action at p. 11, ¶10. Clearly, however, the claimed invention requires “a mobile communication device [having] a program to perform the operations of ... determining whether said communication service can be satisfied by the mobile communication device as a stand alone device.” Thus, the Office’s assertion (for which Applicants cannot find support, nor was support provided by the Office) that a server is making an initial determination is off-point and has no bearing on the claimed invention. Moreover, the Office’s statement that: “Therefore, once the user selects the appropriate features and services then it is determined that the mobile device can act as a stand-alone device,” respectfully, also has no bearing on the claimed invention. *Id.* at p. 12. *Dusse* simply does not disclose “a mobile communication device [having] a program to perform the operations of ... determining whether said communication service can be satisfied by the mobile communication device as a stand alone device,” as recited in independent claim 24.

For the reasons set forth above, Applicants submit that independent claims 1, 12, and 24 define patentable subject matter. Claims 2, 13, 25, and 28 depend from independent claims 1, 12, or 24 and therefore, also define patentable subject matter. Accordingly, Applicants request that the § 102(e) rejections of claims 1, 2, 12, 13, 24, 25, and 28 be withdrawn.

The Office Action has also rejected claims 3-7, 19, and 27; 20-23; and 8-11, 14-18, 26 under 35 USC 103(a) as being unpatentable over *Dusse* in view of *Marwell*; in view of *Marwell* and further in view of *Calder*; and in view of *Kahan*, respectively. The *Dusse* reference, either alone or in combination with *Marwell*, *Calder*, and/or *Kahan*, fails to establish a *prima facie* case of obviousness for at least the reason that the prior art references when combined do not teach or suggest all the claim limitations. All of the claims rejected under 35 USC 103(a) are ultimately dependent upon claims 1, 12, and 24. As stated above, *Dusse* fails to disclose elements found in each of these independent claims. *Marwell*, *Calder*, and *Kahan* do not remedy the deficiencies of *Dusse*.

Marwell relates to a personalized directory assistance system. The system allows a user to dial and speak with a customer service representative who can then search through the user's personal contact list in accordance with the user's request. The customer service representative can then connect the user to the desired personal contact.

Calder relates to a contact management system that can manage contact information and the contents of a wireless telephone's phone book memory. The contact management system enables the collection and maintenance of information pertaining to a plurality of contacts, including voice telephone numbers of the contacts. The contact management system also enables selection and grouping of user-identified voice telephone numbers into lists, which are independently selectable and downloadable to a wireless telephone via a communication interface. The communication interface is capable of choosing an appropriate device driver, which is compatible with the wireless telephone.

Kahan relates to the aggregation of data items to be sent to a mobile terminal subscriber. A subscriber provisioning profile is used to select desired data items, from a plurality of data items, for display on a mobile terminal. The subscriber provisioning profile contains the mobile terminal subscriber's preferences concerning the data items, and the data items are formatted for display according to the mobile terminal subscriber's provisioning profile.

For the reasons set forth above, Applicants submit that independent claims 1, 12, and 24 define patentable subject matter. Claims 3-11, 14-19, 20-23, and 26-27 depend from independent claims 1, 12, or 24 and therefore, also define patentable subject matter. Accordingly, Applicants request that the 35 USC 103(a) rejections of claims 3-11, 14-19, 20-23, and 26-27 be withdrawn.

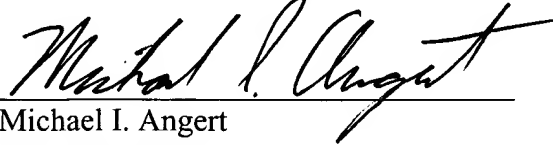
Conclusion:

The claims are allowable over the prior art for the reasons set forth above. A Notice to that effect is respectfully requested.

The Office is hereby authorized to charge all required fees, including all required claim fees under 37 C.F.R. §1.16 and/or all required extension of time fees under 37 C.F.R. §1.17, or credit any overpayments to Deposit Account 11-0600.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Respectfully submitted,

A handwritten signature in black ink, reading "Michael I. Angert", written over a horizontal line.

Michael I. Angert
Reg. No. 46,522

Date: March 3, 2005

Kenyon & Kenyon
1500 K Street, NW, Suite 700
Washington, D.C. 20005-1257
Tel: (202) 220-4393
Fax: (202) 220-4201